REMARKS

This Amendment responds to the Office Action dated August 9, 2005.

The Examiner rejected claims 1-4, 6, and 8 under 35 U.S.C. § 102(a) or 102(b) as being anticipated by asserted admitted prior art described in applicant's Background of the Invention and FIGS 1 and 2. The Examiner rejected the remaining claims under 35 U.S.C. § 103(a) as being obvious in view of the combination of the asserted admitted prior art with respective ones of Yassine, U.S. Patent No. 5,835,997, Navratil et al., U.S. Patent App. Pub. No. 2003014861, and Streib et al., U.S. Patent No. 6,031,383.

As a preliminary matter, the applicant notes that FIGS. 1 and 2 of the present application show a wafer probe station having a chuck with an upper surface for supporting an electrical device and a series of downwardly directed probe tips 16. When these probe tips contact an electrical device supported by the chuck, an electrical connection is made between the probe tips and the upper surface of the chuck. However, the applicant does not believe that any of the probe tips could reasonable be considered "second conductive members" as claimed in independent claim 1 because claims 7 through 9, which depend from independent claim 1, each recite additional limitations that the claimed "second conductive member" be interconnected to one or more of those probes, hence must be separate elements. Nonetheless, the applicant has further amended independent claim 1 to clarify that the claimed "second conductive member" has "a substantially planar surface spaced apart from, and opposed to, said support surface of said chuck." None of the probe tips 16 meets this limitation. The applicant also notes that the probe tips 16 carry a test signal to an electrical device resting on the chuck and the suspended member 24 operates as a guard to this test signal, hence any implication by the examiner that the claimed "second conductive member" reads on a combination of the suspended member 24 with the probe tips 16 is irrational, given that these two elements not only must be separate from each other, but also perform different functions.

With respect to the Examiner's rejection of claims 1-10 in view of applicant's FIGS. 1 and 2, which depict a prior art probe station, the applicant respectfully requests that the Examiner

withdraw the rejection. Although these figures show a "second conductive member" (the suspended guard 24) as claimed in independent claim 1, neither figure expressly shows, nor requires, the additional claimed limitation of "wherein said support surface is electrically interconnected to said second conductive member." In fact, these figures, along with the accompanying portions of the specification, indicate that these two members are electrically isolated from one another.

In an office action dated July 13, 2004, the Examiner required that FIG. 1 of the present application be labeled as prior art and asserted that this figure disclosed all claim limitations of independent claim 1. Specifically, the Examiner contended that FIG. 1 showed an electrical device 18 supported by the upper surface of the top stage of a chuck; a "second conductive member" 24 suspended above the electrical device; and an electrical connection 22 and 26 between the top stage of the chuck and the suspended "second conductive member" 24. In a response dated December 30, 2004, the applicant correctly noted that the suspended member 24 of FIG. 1 was connected to a *guard signal* through an electrical connection 26 and that the guard signal was also connected through a cable 22 to the *middle stage* of the chuck, and not the top stage of the chuck. *See* Specification at p. 3 lines 20-27. Though the middle stage also included an upwardly directed skirting component that surrounded the periphery of the top stage, no electrical contact was shown between that skirting component and the top stage of the chuck, and indeed could not have been shown because the middle stage and skirting component were described as being *an electrical guard.* (If the suspended guard member 24 were connected to the supporting surface of the chuck, it could not provide a *guard* signal because of the short between the signal and guard paths). Hence, the applicant definitively showed that FIG. 1 *did not* disclose that the suspended guard 24, which the Examiner contended was a "second conductive member," was electrically interconnected with the top stage of the chuck.

In an office action dated March 21, 2005, the Examiner required that applicant's *FIG. 2* be labeled as prior art and asserted that this figure disclosed all claim limitations of independent claim 1. In a response dated June 24, 2005, the applicant again correctly noted that FIG. 2 was described in the specification as "a schematic illustration of the probe station of FIG. 1." Hence, since FIG. 1 showed a probe station without the claim limitation recited above, the Examiner's

reliance upon FIG. 2 is equally misplaced. Specifically, though FIG. 2 schematically shows a chuck, a "second member" suspended above the chuck and an electrical connection between the suspended second member and the *chuck*, FIG. 2 does not show an electrical connection between the *surface of the chuck* and the suspended second member. To the contrary, since FIG. 2 is nothing more than a more generalized depiction of the *same probe station* as FIG. 1, which shows a suspended "second member" *electrically isolated* from the surface of the chuck, the Examiner's assertion that FIG. 2 anticipates claim 1 is simply false.

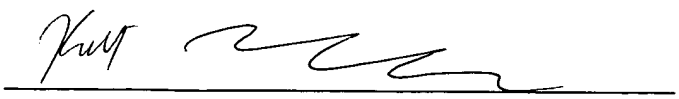
The applicant's response also correctly cited relevant portions of the Manual of Patent Examining Procedure requiring that the examiner support an anticipation rejection with a reference that either *expressly or inherently* discloses every claim limitation. *See* MPEP § 2131. That is to say, any rejection under 35 U.S.C. § 102 must be solely based upon what a reference either (1) actually says or (2) must have. *See Id.* at § 2131.01 (Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference."). The Examiner may therefore not rely upon missing detail as evidence that the reference discloses a specific claim limitation. This is particularly true when the Examiner relies upon a schematic drawing of second, more detailed figure that shows that the claimed limitation is absent from the depicted prior art.

Now, in the present office action, the Examiner simply asserts that *FIGS. 1 and 2* disclose each of the limitations claimed in independent claim 1. The Examiner again bases the rejection upon the false assumption that the suspended guard 24 is electrically interconnected to the top stage of the chuck through the transmission lines 22 and 26. The Examiner seems to rely upon a statement made in applicant's Background of the Invention, which generically describes prior art probe stations as having an upper stage for conducting a test signal and a middle stage for conducting a guard signal. The examiner posits that, because the applicant did not affirmatively state that these stages were electrically insulated from each other, an electrical signal can travel between the two, to electrically interconnect the suspended guard 24 with the upper surface of the chuck. The problem with the Examiner's reasoning is threefold. First, the cited passage in the Background of the Invention did not reference FIGS. 1 and 2, which were not discussed until a later section of the application. The Examiner's reliance on this passage to

imply an electrical interconnection between specific features shown in the drawings is therefore improper. Second, the Examiner's reasoning is *specifically prohibited* by the Manual of Patent Examination Procedure, which states that when rejecting a claim as being anticipated under 35 U.S.C. § 102, an Examiner is limited to the features either expressly shown, or necessarily present in, the cited reference. Therefore, the Examiner was not allowed to make the assumption of an electrical path between the upper and middle stages of the chuck shown in FIGS. 1 and 2 of the present application. This error is exacerbated by the fact that FIG. 1, cited in the rejection and schematically shown in FIG. 2, actually shows the upper and middle stages of the chuck being separated by insulators (note the spacers between the two stages and that none of the screws inset into the top stage contact the middle stage). Finally, to the extent that the Background of the Invention describes prior art chucks as having a top stage for conducting a test signal and a middle stage for conducting a guard signal, the presence of electrical *separation* between the two is not only implicit, but *necessary*, otherwise the middle stage could not provide a guard signal at all. Accordingly, independent claim 1, as well as its dependent claims 2-10, each patentably distinguish over the cited prior art of applicant's FIGS 1 and 2 and the Background of the Invention, because neither figure, or the generic description of prior art probe stations, discloses the limitation of "a second conductive member having a substantially planar surface spaced apart from, and opposed to, said support surface of said chuck, wherein said support surface is electrically interconnected to said second conductive member."

In view of the foregoing remarks, the applicant respectfully requests reconsideration and allowance of claims 1-10.

Respectfully submitted,



Kurt Rohlfs
Reg. No. 54,405
Tel No.: (503) 227-5631